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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,903	11/17/1997	HIROSHI HARUKI	826.1431/JDH	4920

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/971,903

Applicant(s)
Haruki et al

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 31, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 31, 2003 has been entered.

Response to Amendment

2. The preliminary amendment filed on July 31, 2003 has been considered but is ineffective to overcome the Todd et al (5,867,714) reference.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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4. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Todd et al (5,867,714).

Claims 1, 10-13, 16, and 17: Todd discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 13, lines 45-49 and col 14, lines 25-35); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 12, lines 30-65);

c. Extracting information about the new or updated product from one of the remote databases and transmitting the information to the user (col 14, lines 25-35);

Todd further discloses tracking usage data (i.e. number of uses) and using the data to provide targeted suggestions/offers to the user (col 4, lines 31-34 and col 12, lines 30-65).

Since these suggestions/offers are based on the type of information requested by the user during the registration step above, it is inherent that the targeted suggestions/offers are from vendors which sell products that may be of interest to the user.

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Claim 2: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 1 above, and further discloses means for the user to request new information about a product from the general management means (col 13, lines 45-49; col 14, lines 1-5; and col 14, lines 26-36).

Claim 3: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 6, lines 50-55 and col 11, lines 43-58).

Claim 4: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses:

- a. A personal identification number as part of the registration information (col 13, lines 45-49 and col 14, lines 25-35); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 13, lines 47-49; col 14, lines 1-5; and col 14, lines 26-36).

Claims 5 and 6: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses basing the automatic update of the software on the number of times the application had been accessed. Todd discloses a subscription-based service that analyzes license and maintenance agreements before updating the software (col 12, lines 58-65) and that usage data is being tracked (col 4, lines 31-34 and col 12,

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lines 30-65). This implies that the subscription is based on the usage of software (i.e. number of uses), probably also tied to a predetermined time period (i.e. 10 uses per month)

Claims 7, 8, 14, 15, and 18-20: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses multiple vendors (remote data sources)(col 13, lines 16-28) updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user (col 12, lines 21-29 and col 12, lines 49-65). Todd discloses that the data is being revised on the remote data source which is part of a network of processing systems (col 13, lines 16-19) and contains a library of revisions (col 14, lines 18-20). Todd's further disclosure that the user may be able to actually purchase the update/new software from the remote data source (col 12, lines 53-57) and that at least one of the remote data servers could be a central data source (col 14, lines 41-46), implies that the central data source is being updated by the other remote data sources (i.e. vendor/manufacture). Since the new information provided to the user is based on the type of product requested by the user during the registration step above, it is inherent that the vendor sells products which may be of interest to the user.

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Response to Arguments

5. Applicant's arguments filed on July 31, 2003 have been fully considered but they are not persuasive.

a. The Applicant argues that Todd is directed towards hardware upgrades, not towards upgrading software products (page 11). The Examiner notes that Todd explicitly discloses presenting upgrades to the user's present software in all of the claims and even in the title ("System and Method for Distributing Configuration-Dependent Software Revisions to a Computer System") and Abstract ("The remote data source then transmits to the computer system software revisions that are capable of resolving the inherent conflicts."). Todd further discloses that these upgrades can be based on the usage of the software program (col 4, lines 30-42 and col 12, lines 30-49).

b. The Applicant also argues that Todd does not disclose a registration database which includes requests for information submitting by the user during the registration process. The Examiner notes that Todd's registration database contains many types of information receiving from the user during the registration process and detected by the system during use. By registering with the system and providing the information needed for the system to track and automatically update or make update suggestions pertaining to the hardware and software, the user is requesting the system provide the desired information and the appropriate times. Todd even gives an example of such using an AT&T Tourguide Tutorial, version 1.5 installed on the user's computer (col 12, lines 21-29). The system automatically advises the user that a revision is

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available to the on-line documentation, implying that the user has requested such information while registering not only his system but also the software (AT&T Tourguide Tutorial). His disclosure that the user's system is licensed or otherwise qualified to receive analysis and software revision (col 12, lines 58-65) and can be part of a subscription-based service even more clearly implies that the user has indicated (and paid for) which analysis and software revisions are desired.

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

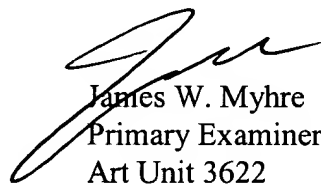
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
September 8, 2003



James W. Myhre
Primary Examiner
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